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| APPLICATION NO.                                                                                                       | FILING DATE | FIRST NAMED INVENTOR        | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------------------------------------------------------------------------------------------|-------------|-----------------------------|---------------------|------------------|
| 10/519,951                                                                                                            | 12/29/2004  | Markus Oles                 | 263603US3X PCT      | 7365             |
| 22850 7590 03/06/2009<br>OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                             |                     |                  |
| EXAMINER<br>WATKINS III, WILLIAM P                                                                                    |             |                             |                     |                  |
| ART UNIT<br>1794                                                                                                      |             | PAPER NUMBER                |                     |                  |
| NOTIFICATION DATE<br>03/06/2009                                                                                       |             | DELIVERY MODE<br>ELECTRONIC |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/519,951

**Applicant(s)**

OLES ET AL.

**Examiner**

William P. Watkins III

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-30 and 32-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-30 and 32-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 12/10/2008; 9/24/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

1. The objection to the disclosure given in section 2 of the detailed portion of the office action mailed 8/13/2008 is withdrawn in view of applicant's amendments to the specification filed 24 November 2008.

2. Claims 28-30 and 32-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is not clear where the new limitation of the aspect ratio being based on an average height and an average width is supported in the original specification. On page 12 there is only support for the maximum height and maximum width of the structure of the elevations formed by the particles being used for the aspect ratio.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 28-30 and 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller et al. (U.S. 2002/0016433 A1).

Keller et al. teaches the use of nano-meter size particle agglomerates that are at least partially exposed to form a self cleaning hydrophobic surface when bound by a polymer binder that forms a substrate for the particles (abstract). The instant invention claims particles that have been pushed into and held in a plastic substrate to form a self cleaning hydrophobic surface. It would have been obvious to one of ordinary skill in the art that there is no substantial difference between the final form of particles in a resin binder that has been coated and particles that have been pushed into a plastic resin . The process of flame spraying to push the particles into the plastic substrate layer is not given much weight as it is unclear how it differs from particles held by a coated binder. Keller et al. teaches many different final applications (section 0087). As the particles protrude from the binder surface, at least a portion of them will form an elevation that has a width larger than the height. As the surfaces of Keller et al. are highly hydrophobic, they are taken as having a similar small difference in advancing and receding angles as instantly claimed.

5. Claims 28-30 and 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller et al. as applied to claims 28-30 and 32 above, and further in view of Krech (U.S. 6,258,201 B1).

Keller et al. teaches exposed particles applied with a plastic binder coating as noted above. Krech teaches forming an exposed particle surface in a plastic substrate by

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flame spraying the particles in the surface (abstract). It would have been obvious to one of ordinary skill in the art to have used the alternate process of Krech using flame spraying in order to form a particle sheet for lamination to a substrate instead of coating the substrate with liquid polymers in order to avoid handling solvents at the final installation point because of the teachings of Krech. It is an obvious matter for one of ordinary skill in the art to select different manufacturing processes from a limited set of known processes in order to form a specific article. This rejection gives full weight to the flame spraying limitation.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 28-30 and 32-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,811,856. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art that a similar final product is made.

8. Claims 28-30 and 32-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-20 of copending Application No. 10/506,993. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art that a similar final product is made.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented

9. Claims 28-30 and 3-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/506,238. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art that a similar final product is made.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 28-30 and 32-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/506,236. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art that a similar final product is made.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 28-30 and 32-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 21-29 of copending Application No. 10/506,994. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art that a similar final product is made.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 28-30 and 32-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/506,604. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art that a similar final product is made.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 28-30 and 32-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 5-24 of copending Application No. 10/474,624. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art that a similar final product is made.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 28-30 and 32-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19-20 and 22-25 of copending Application No. 10/309,895. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art that a similar final product is made.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Applicant's arguments filed 24 November 2008 have been fully considered but they are not persuasive.



Applicant argues that Keller et al. has a binder, while the instant claims exclude a binder. The examiner disagrees. Sections 0078 and 0076 of the reference teach that a whole molded body may consist of the claimed binder and particle composition or only a surface portion. If the whole body is of the binder and particle or the base of the body is the binder and the surface the binder and particles, it is unclear how this structure would differ from a molded body of the thermoplastic used for the binder of Keller et al. that had particles inserted in the surface by the instant disclosed process.

Regarding the rejection of Keller et al. in view of Krech applicant argues that there is no motivation to exclude the binder of Keller et al. The examiner disagrees. Krech discusses in great length at col. 1, lines 10-65, the disadvantages of using adhesives and solvents in terms of pollution and curing times. The use of the process of Krech avoids these problems. It would have been obvious to one of ordinary skill in the art to substitute the process of Krech for particles on a hydrophobic thermoplastic substrate in Keller et al. in order to avoid the use of solvents and adhesives. The use of other additives in Krech is optional and not required for the process. If the substrate of Keller et al. is of a thermoplastic similar to that used as the binder, and the particles are implanted using the process of Krech, it would produce a similar product to that taught by Keller et al. There would be no destruction of the function or purpose of Keller et al. as argued by applicant.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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WW/ww

March 4, 2009

/William P. Watkins III/

Primary Examiner, Art Unit 1794